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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,257	09/16/2003	Wolfgang Beilfuss	0503-1154	2873

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YOUNG & THOMPSON
209 Madison Street
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Alexandria, VA 22314

EXAMINER

HAGOPIAN, CASEY SHEA

ART UNIT	PAPER NUMBER
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1615

NOTIFICATION DATE	DELIVERY MODE
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02/22/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DocketingDept@young-thompson.com

Office Action Summary	Application No. 10/663,257	Applicant(s) BEILFUSS ET AL.	
	Examiner Casey S. Hagopian	Art Unit 1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-25,30,31,35-48,57 and 58 is/are pending in the application.
- 4a) Of the above claim(s) 22,24 and 25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18-21,23,30,31,35-48,57 and 58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 18, 35 and 37-39 have been amended. Claims 32-34 have been cancelled. No new claims have been added. Claims 22, 24 and 25 were previously withdrawn. Thus, claims 18-21, 23, 30, 31, 35-48, 57 and 58 are currently under consideration.

It is noted that the claim set dated 1/19/2010 does not identify claim 24 as withdrawn, however at page 10 of Remarks it is stated correctly that claims 22, 24 and 25 are withdrawn. It is requested that applicant correct the claim identifier of claim 24 at the time of the next correspondence.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 1/19/2010 has been entered.

WITHDRAWN REJECTIONS

Applicant's amendments have been fully considered and are persuasive. Therefore, the rejection under 35 USC 103 has been withdrawn. However, upon further consideration, a new ground(s) of rejection under 35 USC 103 is made over the combination of Beilfuss et al. and Ecanow et al.

NEW REJECTIONS

In light of Applicant's amendments and after further consideration, the following rejections have been newly added:

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 18 and 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation in claim 18, "wherein said formal and said emission-reducing additive are present in a ratio that ranges from about 100:1 to about 10:1 of the preservative" can be interpreted such that the ratio is a formal to an emission-reducing agent or it can be interpreted such that the ratio is the formal + the emission-reducing agent to the preservative. The latter is particularly confusing because the composition is a preservative and would always be a larger amount than one of its parts such as the formal or emission-reducing agent. At page 9, lines 32-34 of Specification it states that a preferred embodiment of the invention relates to a preservative in which the weight ratio (a):(b) is in the range 100:1 to 10:1, wherein (a) is a formal and (b) is an emission-reducing agent. For improved clarity and consistency, it is requested that applicant replace said limitation with "wherein the weight ratio of said formal to said emission-reducing additive is in the range of about 100:1 to 10:1".

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Claim 35 includes a similar limitation as the one discussed above but narrower in range. It is requested that applicant amend the limitation according to the recommendation discussed above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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Claims 18-21, 23, 30, 31, 35-48, 57 and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beilfuss et al. (US 2001/0021711 A1) in view of Ecanow et al. (USPN 4,452,780).

Beilfuss et al. teaches a stable microbicidal composition comprising a) at least one bactericidal N-formal, b) at least one fungicide and c) at least one stabilizer (claim 1). A preferred bactericidal N-formal is 3,3'-methylenebis(5-methyloxazolidine) (paragraph [0019]; claim 3). Beilfuss et al. teaches the N-formal is present in a concentration of from 1 to 99% by weight, preferably from 10 to 95% by weight, more preferably 20 to 90% by weight, in particular 40 to 90% by weight (claim 4) and the fungicide is present in a concentration of from 0.1 to 99% by weight, preferably 2 to 40% by weight, in particular 5 to 10% by weight (claim 7). Said percentages read on the ratios claimed in instant claims 18 and 35. Beilfuss et al. teaches said composition is free from iodopropynyl compounds and derivatives of benzimidazole or thiophene (paragraph [0027]). Beilfuss et al. further teaches that additional additives may be included in the compositions such as solvents, solubility promoters and corrosion-protective agents (paragraphs [0023] and [0026]). Regarding instant claims 36-40, Beilfuss et al. teaches that the compositions are preferably anhydrous or have a low content of water (paragraph [0024]). It is noted that claims 37-39 contain the limitation, up to about X%. For instance, claim 37 limits the water content of the composition to be up to about 10%, which broadly reads on 0% or anhydrous. Regarding instant claims 41-48, Example 3 exhibits a composition comprising 90% of the N-formal 3,3'-methylenebis(5-methyloxazolidine) and about 2.5% of a fungicide (paragraph [0050]). Beilfuss et al. also teaches the preferred solvent, phenoxyethanol as well as amounts of

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solvent utilized in the composition including less than 50% by weight, preferably less than 35% by weight and in particular less than 25% by weight (claims 13 and 14).

It is noted that the instant claims are product claims and any intended use recitation such as “preservative” (all claims) or “is utilized for...” (claims 57 and 58) does not alone show patentable distinction. A recitation of intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. In other words, if the prior art structure is capable of performing the intended use, then it meets the claim.

Beilfuss et al. is silent to urea.

Ecanow et al. teaches a composition possessing powerful germicidal, antiseptic, fungicidal and bacteriacidal properties comprising an active agent selected from iodine, urea or an iodophore or any combination thereof (abstract; claim 1). Thus, Ecanow et al. generically teaches urea as a known agent effective against fungus.

One of ordinary skill in the art at the time of the invention would have been motivated to include urea as the “at least one fungicide” with a reasonable expectation that said urea would impart effective fungicidal properties. Thus, in Beilfuss et al. it would have been obvious at the time the invention was made to include the fungicide, urea, as suggested by Ecanow et al.

Beilfuss et al. is also silent to some of the particular percentage ranges claimed in the instant claims 43-48, however it would be within the knowledge of one skilled in the art to optimize a composition by way of routine experimentation. As discussed above, Beilfuss et al. teaches the N-formal is present in a concentration of from 1 to 99% by weight, preferably from 10 to 95% by weight, more preferably 20 to 90% by weight, in particular 40

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to 90% by weight (claim 4) and the fungicide is present in a concentration of from 0.1 to 99% by weight, preferably 2 to 40% by weight, in particular 5 to 10% by weight (claim 7). Example 3 exhibits a composition comprising 90% of the N-formal 3,3'-methylenebis(5-methyloxazolidine) and about 2.5% of a fungicide (paragraph [0050]). Beilfuss et al. also teaches the preferred solvent, phenoxyethanol as well as amounts of solvent utilized in the composition including less than 50% by weight, preferably less than 35% by weight and in particular less than 25% by weight (claims 13 and 14). Absent of unexpected results, a practitioner would have reasonably expected an optimized composition comprising 3,3'-(methylenebis(5-methyloxazolidine), urea and, if necessary, phenoxyethanol in the percentages claimed. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to optimize the composition and include the particular percentages claimed by applicant.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-21, 23, 30, 31, 35-48, 57 and 58 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 18, 20-30, 32-34 and 36-38 of copending Application No. 11/088428.

Claim 18 of application '428 reads:

A composition with reduced formaldehyde and amine emission which may be used as a preservative, comprising: a) between about 70% to about 95%, by weight, of N,N'-methylenebis(5-methyloxazolidine); b) between about 2.5% to about 15%, by weight, of urea; and c) between about 2.5% to about 15%, by weight, of monoethylene glycol, wherein said composition comprises less than about 10%, by weight, of water.

Claim 18 of the instant application reads:

A preservative with reduced formaldehyde emissions which comprises: a) at least one formal; and b) at least one emission-reducing additive, wherein, said at least one emission-reducing additive comprises urea wherein said formal and said emission-reducing additive are present in a ratio that ranges from about 100:1 to about 10:1 of the preservative.

Although the conflicting claims are not identical, they are not patentably distinct from each other at least because claim 18 of the copending application '428 anticipates claim 18 of the instant application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Conclusion

All claims have been rejected; no claims are allowed.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Casey Hagopian whose telephone number is 571-272-6097. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert A. Wax, can be reached at 571-272-0623. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Casey S Hagopian/
Examiner, Art Unit 1615

/Robert A. Wax/
Supervisory Patent Examiner, Art Unit 1615